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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,620	03/29/2001	Daniel G. Streibig	4052-7414	4111

21888 7590 08/21/2003

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,620

Applicant(s)

STREIBIG, DANIEL G.

Examiner

Jordan M. Schwartz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/9/03 and interview of 7/24/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,10 and 22-44 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-7 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Examiner's Comment***

The notice of non-responsive sent out on July 18, 2003 has been withdrawn and this office action is being sent out in its place.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neefe patent no. 4,701,038.

Neefe discloses the limitations therein including the following: a colored contact lens (abstract, column 2, line 22); comprising a non-opaque pupil section (Figure 4, "3", column 3, line 22); a generally annular-shaped iris region surrounding the pupil region (Figure 4, "1"). The iris region of Neefe will inherently cover at least 80% of the iris, this being reasonably based upon what is disclosed in Figure 4. Neefe further discloses the pattern comprising distinct elements with at least 25% having a surface area no greater than 6000 or 1000 square microns (column 3, line 25 and claim 1 with each "reflecting particle" being the claimed "distinct element"). In reference to the claimed "multi-color" pattern, Neefe further discloses that the coloring can comprise "pigments" (plural) being mixed together (column 2, line 22 to column 3, line 32) which would make obvious to a person of ordinary skill in the art the pattern being multi-

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colored. Regardless, it is well known in the art of colored contact lenses for such lenses to include more than one coloring in the iris section in order to provide a lens of a more natural appearance. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the iris portion of Neefe as "multi-colored" since it is well known in the art of colored contact lenses for such lenses to include more than one coloring in the iris section in order to provide a lens of a more natural appearance.

Claims 22-27 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo et al document number 2002/0039172 (hereinafter referred to as "Ocampo'172").

In reference to claims 22-27, Ocampo'172 discloses the limitations therein including the following: a colored contact lens (abstract) comprising a non-opaque pupil section (Figure 1, "20", section "0027"); a generally annular-shaped iris region surrounding the pupil region (Figure 1, "22", section "0027"). The iris region of Ocampo'172 will inherently cover at least 80% of the iris, this being reasonably based upon what is disclosed in Figure 1, as well as it being well known that colored contact lenses have iris regions that cover a majority of the iris portion. Ocampo'172 further discloses that the coloring is made up of "pigments" that are 3 microns or smaller ("0066"). Each of these pigments that make up the coloring can be considered as a "distinct element" and therefore each of at least 25% would have a surface area no greater than 6000 or 1000 square microns. Regardless, if one considers each of the pixels (instead of each of the pigments) as the "distinct elements", then having a pixel

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size of less than 88 microns in diameter would satisfy the limitation of claim 22.

Ocampo'172 teaches that the coloring can be applied by ink-jet printing ("0063-0064") and further that preferred ink-jet printers have pixels less than 150 microns in diameter and more preferably less than 100 microns in diameter to provide printing of greater quality ("0083"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the "distinct elements" of Ocampo'172 as having a surface area no greater than 6000 square microns since Ocampo'172 teaches that it is desirable for the diameter of the pixels to be less than 100 microns and for the desirability of having smaller pixel sizes for the purpose of providing printing of greater image quality. Furthermore, applicant is claiming that the pixel sizes should be smaller and smaller i.e. less than 4000 square microns, less than 2000 square microns, less than 1000 square microns which modification would involve a mere change in size of a component. It has been held that a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, as stated above, Ocampo'172 teaches of the desirability of pixel sizes being smaller and smaller including less than 100 microns in diameter (7,850 square microns) and therefore, applicant's claims of "less than 6000 square microns, less than 4000 square microns etc" is merely optimizing a disclosed range. It has been further held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art *In re Aller*, 105 USPQ 233.

In reference to claims 41-42, Ocampo'172 discloses as is set forth above but does not specifically disclose the claimed "at least twenty five different colors". However, Ocamp'172 teaches that the number of colors can be manipulated through software and that the more colors used, the closer the lens approximates the human eye ("0013"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens of Ocampo'172 as comprising at least twenty-five different colors since Ocamp'172 teaches that the number of colors can be manipulated through software and that the more colors used, the closer the lens approximates the human eye. Furthermore, Ocampo'172 teaches of the desirability of having many colors and the specific number of colors would be merely optimizing the range of colors. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art *In re Aller*, 105 USPQ 233.

Claims 28-29 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo'172 in view of Atkins et al patent no. 6,132,043 (hereinafter referred to as "Atkins et al").

In reference to these claims, Ocampo'172 discloses as is set forth above and further discloses that the patterning can be in the form of dots ("0039" and "0072") but does not specifically disclose "at least 800" or "at least 3000" as claimed. Atkins et al teaches that the patterning can have "at least 800" or "at least 3000" dots to provide the required enhanced cosmetic appearance (Figure 1, column 2, lines 3-14). Atkins et al further teaches that the patterning can have more or less dots to provide the required

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cosmetic appearance (column 3, lines 32-36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the dot patterning of Ocampo'172 as comprising "at least 800" or "at least 3000" as claimed since Atkins et al teaches that the patterning can have "at least 800" or "at least 3000" dots as well as that the patterning can have more or less dots to provide the required cosmetic appearance. Regardless, the claimed number of dots of the patterning is again optimizing a range and as stated above, it has been further held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art *In re Aller*, 105 USPQ 233.

Claims 30-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo'172 in view of Tucker document no. 2001/0050753.

In reference to these claims, Ocampo'172 discloses as is set forth above including that the colored pattern can be applied by ink-jet printing ("0063"-0064") but does not specifically disclose the elements within 50 microns of each other. Tucker teaches that when printing colored contact lenses through the use of an inkjet printer that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns from each other to provide improved printing quality (abstract, "0049", "0051").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the elements of Ocampo'172 as being within 50 microns of each other since Tucker teaches that when printing colored contact lenses through the use of an inkjet printer that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns from each other to provide

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improved printing quality. The claimed number of distinct elements is again optimizing the range of elements within the lens which optimization would be obvious to a person of ordinary skill in the art for the reasoning set forth above.

Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins et al in view of Tucker.

Atkins et al discloses the limitations therein including the following: a colored contact lens (abstract) comprising a non-opaque pupil section (Figure 1, "20", column 3, line 15); a generally annular-shaped iris region surrounding the pupil region (Figure 1). The iris region of Atkins et al will inherently cover at least 80% of the iris, this being reasonably based upon what is disclosed in Figure 1, as well as it being well known that colored contact lenses have iris regions that cover a majority of the iris portion. Atkins further discloses a multi-color pattern on the iris (column 3, line 56); the pattern comprising at least 3000 distinct elements (Figure 1 i.e. each dot being a "distinct element"). Atkins et al discloses as is set forth above but does not disclose each element within 10 microns of each other. Tucker teaches that when printing colored contact lenses, an inkjet printer can be used and that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns from each other to provide improved printing quality (abstract, "0049", "0051"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the elements of Atkins et al as being within 10 microns of each other since Tucker teaches that when printing colored contact lenses through the use of an inkjet printer that the pixels i.e. the adjacent elements are preferably closer together including



less than 50 microns (which would include less than 10 microns) from each other to provide improved printing quality.

***Response to Arguments***

As stated in the attached interview summary, the examiner had initially been informed that the burden is on applicant to obtain copies of required provisional applications and the examiner was instructed to send out a non-responsive action in response to applicant's arguments. After the telephone interview of July 24, 2003 and upon further consultation, the examiner was informed that since it is not the official policy of the office for the burden to be on applicant in obtaining copies of required provisional applications, applicant's arguments were correct and therefore the burden was still on the examiner to provide the required copies. Therefore, the non-responsive action has been withdrawn and this non-final action is being sent out. While the applicant certainly has the right to disagree with the examiner's position and provide arguments in support of their own position, it would have been appreciated by the examiner if, in the telephone conversation of July 24, 2003, it could have been done by Mr. Norman in a more courteous and professional manner in response to the examiner's explanation as to why a non-responsive action had been sent out.

Applicant's arguments filed 5/9/03 have been fully considered but, with respect to the rejections by Neefe patent number 4,701,038, they are not persuasive. Applicant first argues that Neefe fails to disclose or make obvious the multi-color pattern. The examiner disagrees. Neefe discloses pigments (plural) being mixed together. Clearly, any variation in the color depending upon how well the pigments are being mixed

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together will inherently produce more than one color i.e. multi-color. Furthermore, the applicant is under the belief that a 103 rejection requires a teaching reference.

However, as stated in the office action, it is well known in the art of colored contact lenses that are formed by applying pigments for such lenses to have multi-colored patterns to produce a more realistic iris image pattern and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Neefe contact lens as multi-colored for the reasoning set forth in the rejection above. As one example, Thakrar patent number 6,284,161 shows that a single or multi-colored pattern can be applied to a contact lens surface by mixing and applying pigments.

Applicant further argues that the Neefe particles have no color of their own and therefore cannot constitute distinct elements of a multi-color pattern. However, applicant has not claimed "the composite pattern comprising a plurality of distinct multi-color elements". Instead, applicant is claiming a multi-color pattern comprising a plurality of distinct elements. Neefe discloses light reflecting particles imbedded within a colored matrix. The combination of the particles and colored matrix constitute the claimed "multi-color pattern" and the particles constitute the distinct elements. Arguing that the particles are not multi-colored is therefore arguing a limitation that has not been claimed.

For applicant's further information, the examiner has carefully reviewed all three provisional applications related to the above-referenced publications. The specification of the Ocampo provisional application is apparently an exact duplicate of the printed publication and all of the cited limitations are within the provisional application.

Furthermore, all of the cited limitations of the Tucker publication are within its provisional applications as well. Copies of these provisional applications are being sent to applicant together with this rejection.

***Prior Art Citations***

Thakrar et.al patent number 6,284,161 is being cited herein to show a contact lens in which a single or multi-colored pattern can be applied to a contact lens surface by mixing and applying pigments. This reference is being cited to supply additional support for the examiner's argument that it is well known in the art of colored contact lenses for such lenses to include more than one coloring in the iris section in order to provide a lens of a more natural appearance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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A handwritten signature in black ink, appearing to read 'JMS', with a large, stylized loop at the end.

Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
August 5, 2003